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BEVER HOFFMAN & HARMS, LLP TRI-VALLEY OFFICE 1432 CONCANNON BLVD., BLDG. G LIVERMORE, CA 94550			WALSH, DANIEL I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/502,812

Applicant(s)

COOK ET AL.

Examiner

Daniel I. Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 and 66-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 and 66-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Receipt is acknowledged of the Appeal Brief received on 18 May 2005.

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 6, 10, 15 19-22 and 73-76 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6-11 of U.S. Patent No. 6,857,569 in view of Godfrey et al. (US 5,288,942).

For instance, in claim 6 of the present claimed invention the Applicants claim:

i) "...portable data card..shape...embedded storage member...storage material...processing by a data processing station...transported relative to each other..." (see claim 6),

For instance, in claim 10 of the present claimed invention the Applicants claim:

ii) “..at least one layer of storage material for storing information in a predetermined format is at least one layer of high density, high coercivity magnetic material for storing magnetic signals” (see claim 10).

For instance, in claim 15 of the present claimed invention the Applicants claims:

iii) “...portable card...substrate...removable and reinsertable...transported relative to teach other...expose at least a portion of said storage member...processing station...” (see claim 115)

For instance, in claim 19 of the present claimed invention the Applicants claim:

iv) “...magnetically permeable, magnetically saturable material.” (see claim 19).

For instance, in claim 20 of the present claimed invention the Applicants claim:

v) ...magnetically permeable, magnetically saturable...non-magnetic friction reducing layer formed on ...” (see claim 20)

For instance, in claim 21 of the present claimed invention the Applicants claim:

vi) “...high coercivity magnetic material...field orientation...magnetically permeable, magnetically saturable...magnetic field orientation...magnetic image field in a direction opposite...” (see claim 21)

For instance, in claim 22 of the present claimed invention the Applicants claim:

vii) "...least two layers wherein said one of said layers includes a magnetically permeable, magnetically saturable...non-magnetic abrasion friction reducing layer...non-magnetic material layer ....responsive through said non-magnetic layer...imagine fielding a direction opposite to said predetermined magnetic field direction." (see claim 22.

For instance in claim 73 of the present claim invention the Applicants claim:

viii) "...accessible embedded storage member...magnetic recording material...transducer...embedment of said storage member..." (see claim 73)

For instance, in claim 74 of the present claimed invention the Applicants claim:

ix) "...abradable protective coating..." (see claim 74).

For instance, in claim 75 of the present claimed invention the Applicants claim:

x) "...magnetically permeable, magnetically saturable material..." (see claim 75)

For instance, in claim 76 of the present claimed invention the Applicants claim:

xi) "...non-magnetic friction resisting material...magnetically permeable, magnetically saturable..." (see claim 76).

Whereas in the '569 Patent the Applicants claim "...a data card comprising a non-magnetic substrate...magnetic material layer...data tracks" (see claim 1). The '569 Patent is silent to an embedded storage member, that the storage member and substrate are transported

relative to teach other to expose the storage member to facilitate processing of stored information and for embedment of the storage member in the substrate, that the member is read by a processing station, and that a transducer is used as well. The Examiner notes that it is well known and conventional for cards and data processing stations to be moved relative to each other in order to process card data, and that transducers are well know and conventional for reading magnetic cards reliably and predictably. The '569 Patent teaches "high density, high coercivity magnetic material..." (see claim 6), an "abradeable protective coating over the magnetic material layer" (see claim 7), "...magnetically permeable, magnetically saturable material...non-magnetic friction reducing layer..." (see claim 8), "...non-magnetic material layer...magnetic material layer...magnetically permeable, magnetically saturable material..." (see claim 9), and "magnetically permeable, magnetically saturable material" (see claim 10), and "non-magnetic material layer...magnetically permeable, magnetically saturable...produce a magnetic image field." (see claim 11). Though silent to the image field being in an opposite direction, the Examiner notes that it would have been obvious to have an opposite field in order to provide protection.

The Examiner has interpreted the claim in light of FIG. 57, 58A that maybe generally referred to as a portable card 950 comprising a substrate 934 enclosing an accessible embedded storage member 932 having at least one layer of storage material, illustrated by arrow 942 for storing information. Accordingly, Godfrey teaches such limitations ((FIG. 3, abstract, and col 1, lines 5+)).

At the time the invention was made, one would have been motivated to combine the teachings of Smith, Sr. et al. with those of Godfrey et al.

One would have been motivated to do this in order to provide a means to protect/ hold the storage medium.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Godfrey (US 5,288,942).

Re claim 1, Godfrey teaches a portable card comprising a substrate having a predetermined shape; and an accessible embedded storage member having at least one layer of storage material for storing information enclosed by the substrate, the storage member and the substrate being adapted to be transported relative to each other to expose at least a portion of the storage member to facilitate processing of stored information and for embedment of the storage member within the substrate (FIG. 3, abstract, and col 1, lines 5+). The Examiner has interpreted the claim in light of FIG. 57, 58A that maybe generally referred to as a portable card 950 comprising a substrate 934 enclosing an accessible embedded storage member 932 having at least one layer of storage material, illustrated by arrow 942 for storing information. Re claim 2, Godfrey teaches an elongated strip member (col 1, lines 13+).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 6-18, 23-40, and 66-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Godfrey.

Re claim 6, the teachings of Godfrey et al. have been discussed above. Though silent to movement, the Examiner notes that it would have been obvious to one of ordinary skill in the art to move the card and the data processing station/reader relative to each other in order to expose the storage member for processing or to embed the storage member for holding/securing the storage member, such as when reading/writing occurs and also when the member is desired to be protected or stored for transport.

Re claim 7, magnetic mediums have been discussed above.



Re claims 8-9, the Examiner notes that optical/magneto-optical storage mediums are well known and conventional in the art, and placing them in a device such as taught by Godfrey et al. would be obvious in order to hold/organize/transport them. The use of magneto-optical/optical data storage cards is an obvious expedient in order to store more data and also provide for security.

Re claim 10, the Examiner notes that it is well known and conventional in the art to have high-density high coercivity magnetic material for suitable properties for recording such as reducing effects from stray magnetic fields.

Re claim 11, the Examiner notes that it is well known and conventional in the art to cover magnetic strips with a protective layer (for protection against wear, for example), and that such a layer can be interpreted as abradable (wearable). Re claims 12-14, the Examiner notes that it is well known and conventional in the art for a data processing station/reader/writer to move relative to the substrate, for the substrate to move relative to the station/reader/writer, or for the two of them to move relative to each other. One would have been motivated to do so, in order to facilitate reading/writing by methods which are conventional in the art to produce expected results such as convenience to the user, reduce wear on the card/station, to ensure accuracy, etc.

Re claim 15, the limitations have been discussed above re claim 14. It is obvious to use a processing station in order to read/write as is known in the art. The storage members are indeed removable and reinsertable into the device of Godfrey et al. for transpiration/protection.

Re claims 16-18, the limitations have been discussed above. Re claim 18, it would have been obvious to form the magnetic strip of thin films, and that they have a predetermined magnet

field to permit storing of data, in order to achieve high recording density, reliability, and low costs. A magnetic field (predetermined) permits writing and reading to be easily performed.

Re claim 23, the limitations have been discussed above re claim 14. The Examiner notes that a rectangular/planar shape is well known and conventional in the art for transportability and convenience/portability.

Re claims 24-28, the Examiner notes that rectangular storage members (magnetic strips), circular storage members arcs/circles), two/three removable/reinsertable members (cards with a plurality of strips), and IC cards are well known and conventional in the art to provide for increases security, data storage capability, etc. It would have been obvious to use such member with the teachings of Godfrey et al. for transportation/protection.

Re claims 29-30, the Examiner notes that it is well known and conventional in the art to read a card with an inductive read head/transducer. One would have been motivated to do so in order to have a means of reading stored data off a storage member, in a manner conventional in the art and ,widely practiced, and in accordance with common standards, by inducing a field.

Re claims 30-33, the Examiner notes that such read heads are well known in the art to produce expected results, and their selection is well within the art for conforming with system constraints, costs, etc. If the Applicant disagrees and suggests that such readers are patentably distinct embodiments, a restriction will be enforced.

Re claims 34-36, the Examiner notes that depending on the orientation of the card and the processing station, the magnetic field orientation of the material can take a parallel, perpendicular, or acute orientation with respect to the processing station. As the claims do not

recite a structural relationship resulting in the orientations of the field, general field orientations are therefore a known property.

Re claims 37-40, the Examiner notes that such means for applying a magnetic material/coating are well known and conventional in the art. If the applicant disagrees and suggests that such means form patentably distinct embodiments, a restriction may be enforced. Further, the Examiner notes that simply adjusting the orientation of a station or a card, is an obvious matter of design variation, as such orientation does not service a particular purpose that is not taught by that which is conventional in the art (reading and writing to magnetic mediums).

Re claims 66-69, the limitations have been discussed above. Re claims 70-72, the Examiner notes that it is well known and conventional in the art for magnetic materials to be isotropic and anisotropic, and that platinum is an isotropic material. The selection of such materials is an obvious expedient in order to accurately store quantities of magnetic data. Re claims 73-74, the limitations have been discussed above.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Godfrey, as applied to claim 1 above, further in view of Liu et al. (US 2001/0052543).

The teachings of Godfrey have been discussed above.

Godfrey is silent to circular storage members.

Liu et al. teaches circular storage members (magnetic) (FIG. 2D-2Q).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Godfrey with those of Liu et al.

One would have been motivated to do this in order to hold several cards, including those with data stripes, and arcs/circular storage.

6. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Godfrey, as applied to claim 1 above, further in view of Middlemiss et al. (US 6,184,788).

The teachings of Godfrey have been discussed above.

Godfrey teaches a means for carrying cards, but is silent to the means/substrate having a first and second layer operatively coupled to each other so that the first layer is movable with respect to the second layer and wherein a storage member is located on at least one of the first or second layer.

Middlemiss et al. teaches such limitations (FIG. 3-FIG. 4) where a clamshell type cardholder is shown. Re claim 5, it is understood that opposite movement of opening (i.e. closing) embeds the storage member in the substrate.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Godfrey with those of Middlemiss et al.

One would have been motivated to do this in order to have a substrate that holds storage members in a clamshell type arrangement, allowing easier access to the storage members/cards while providing more protection.

### ***Response to Arguments***

7. The Examiner notes that the specification discloses that the card holding device is interpreted as the card, and that the embedded storage member is interpreted as the actual memory device. The Examiner has used this interpretation to reject the claims, as set forth above. Additionally, the Examiner notes that many of the claimed limitations are well known and conventional in the art. If the Applicant wishes to discuss such limitations and the holding

that they are well known and conventional in the art, the Examiner directs the Applicant to telephone the Examiner to address such issues, in order to expedite prosecution.

***Additional Remarks***

8. The Examiner notes (re claims 19-22 and 75-76 which were rejected under obviousness type double patenting, but not by an art rejection) that Shiroshi (US 5,147,732) teaches a magnetically permeable magnetically saturable layer (NiFe 23), but that it is not a layer of an abradable protective coating, but rather is a magnetic thin film on a recording side (storage, not protective layers).

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Shiroshi (US 5,147,732).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh

Examiner

Art Unit 2876

10-14-05

A handwritten signature in black ink, appearing to read 'D. Walsh', is written over the typed name and date.